

Attorney Docket No.: MGU-0027  
Inventors: Hanrahan and Luo  
Serial No.: 10/790,273  
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REMARKS

Claims 1-8 are pending in the instant application. The pending claims have been subjected to a Restriction Requirement under 35 U.S.C. §121 as follows:

Group I, claims 1-4 drawn to a method of labeling a cell-surface protein;

Group II, claims 5-6, drawn to a biotin-tag-labeled cell-surface protein; and

Group III, claims 7-8, drawn to a method of identifying molecules that correct protein folding.

The Examiner acknowledges that Group II and Group III are related as product and process of use; however, these groups are suggested as being distinct inventions because the method of identifying compounds can be used to identify compounds that correct the folding of a biotin-tagged tyrosinase molecule. It is further acknowledged that Group II and Group I are related as process of making and product made; however, these groups are suggested as being distinct because the process can be used to tag an NMDA receptor molecule for surface labeling. The Examiner suggests that Groups I and II are distinct both physically and functionally and are not required for another. The Examiner acknowledges that were Applicants to elect claims directed to the product, and the product claim were subsequently allowed, withdrawn process claims that depend from or otherwise include all limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP §821.04. Applicants are required to elect one of the Groups to be examined. Applicants respectfully disagree and traverses this restriction requirement.

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MPEP §803 is quite clear; for a proper restriction requirement, it must be shown: (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

Applicants believe that restriction of the claims as set forth in this paper is not proper, as all of the groups (I-III) of the instant application relate to one single concept, namely a membrane-localized protein comprising a biotin target sequence tag. Applicants respectfully point out that under MPEP 806(c), [w]here inventions are related as disclosed but are not distinct as claimed, restriction is never proper. Furthermore, even if the Examiner should determine that Groups I-III are independent, there would be no search burden on the Examiner because all of the claims are related to the single concept of a membrane-localized protein comprising a biotin target sequence tag. Under MPEP 803 [i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. Applicants submit that the claims are related to one concept and further that the search burden on the Examiner will not be increased due to inclusion of all of the Groups I-III in this application. Accordingly, the instant Restriction Requirement meets neither of the criteria as set forth by MPEP §803 to be proper.

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Reconsideration and withdrawal of this Restriction Requirement is therefore respectfully requested.

Applicants believe that in light of the above remarks they are entitled to have all of the claims of this application examined on the merits. However, in an earnest effort to be completely responsive, Applicants hereby elect to prosecute Group III, claims 7-8, drawn to a method of identifying molecules that correct protein folding, classified in class 435, subclass 7.2, with traverse.

Respectfully submitted,

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